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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/990,670      | 11/16/2001  | Thomas Hicks         | 6414-61471          | 2776             |

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[REDACTED] EXAMINER

TSOY, ELENA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1762     |              |

DATE MAILED: 02/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |               |
|------------------------------|-----------------|---------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |
|                              | 09/990,670      | HICKS, THOMAS |
| Examiner                     | Art Unit        |               |
| Elena Tsoy                   | 1762            |               |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 January 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 4-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|                                                                                                              |                                                                             |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

1. Applicant's election of Claims 4-6 in Paper No. 5 is acknowledged.

Claims 7-18 directed to a non-elected invention have been cancelled. Claims 4-6 are pending in the application.

***Claim Objections***

2. Claims 5, 6 are objected to because of the informalities:

Claim 5, line 2; Claim 6, line 10, applicant is advised to change "the result absorbs" to "the resultant window covering absorbs" for clearer understanding.

Claim 6, lines 16-17, applicant is advised, for clearer understanding, to change "images which have designs that tile together to fill spaces larger than the individual pieces" to "the printed colored image which is assembled from individual pieces" as disclosed in specification (See page 9, line 9).

Claim 5, lines 1-2; Claim 6, lines 9-15; since step (a) of Claim 5 further modifies step (b) of Claim 4; and step (c) in Claim 6 further modifies step (b) of Claim 6, applicant is advised, for clearer understanding, to change "(a)/(c) printing using sunfast UV inks, ultra-violet absorbing varnishes, and hardening agents" to "wherein the printed colored image is produced using sunfast UV inks, and a varnish is applied to the printed colored image, said varnish comprising UV-absorber and a hardening agent", as disclosed in specification (See page 8).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, line 1; Claim 5, line 1; Claim 6, line 1, the use "combines" in preambles of the claims is confusing because no active steps are recited. It is not clear how components (a) and (b) relate to each other. For examining purposes "combines" was interpreted according to specification (See pages 7, 8), as applying the component (b) adjacent or over the component (a).

Claim 5, line 4, Claim 6, line 11, instead of "the qualities described in claim 4", recitation of qualities should be incorporated into the claims because it is not clear to what particular qualities the claims are referring to.

Claim 5, lines 5, 6; Claim 6, lines 2, 13, the term "highly" is a relative term which renders the claim indefinite. The term "highly" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, it is not clear what ranges are intended to be encompassed by this term.

Claim 5, line 7; Claim 6, line 14 "other types of damage" renders the claims indefinite because it is not clear what types of damages the claims are referring to.

Claim 6, line 18, instead of "the properties described in this claim", recitation of properties should be incorporated into the claim because it is not clear to what particular properties the claim is referring to.

Claim 6, lines 18-19, "whereby a window covering is made which has the properties described in this claim" renders the claim indefinite because it is not clear what properties were described in this claim. Recitation of the properties should be incorporated into the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413).**

Charley et al disclose a process comprises applying a printed colored design 20 covered with a very thin layer of *translucent* varnish 36 (See column 2, lines 23-24, 55-58) to a clear or translucent cling vinyl film 16 (See column 2, lines 45-55) of a film material 14, said film 14 being the "FLEXCON" six mil static cling comprising the cling vinyl film 16 on a carrier sheet 18 (See column 2, lines 28-39), thereby forming a *translucent* cling decal for covering window (See column 4, lines 8-9). The cling decal self adheres to window glass (non-porous) surface via static cling (through cohesion and atmospheric pressure) by peeling back the carrier 18 from the film 16 and pressing the film 16 to the glass surface (See column 4, lines 6-15). Charley et al further teach that inks are of Werneke Series (See column 3, lines 13-22), and the varnish is UV-curable varnish (See column 3, lines 20-27).

The Examiner Note: printed colored design 20 covered with a very thin layer of *translucent* varnish in Charley et al is in fact a translucent printed colored image as claimed because according to specification as filed, translucent printed colored image of claimed invention is also made by covering a printed color image with translucent varnish (See specification, pages 7, 8).

Charley et al do not expressly show that the translucent cling vinyl film 16 in the film 14 has thickness in the range of 4-10 mils.

Taylor et al teach that polyvinyl chloride film about 50-150 microns thick (2-6 mils) commonly known as cling vinyl or static cling vinyl are flexible and can be used for carrying an image thereon to produce self-adhering stickers for automobile windows (self-adhering window covering), decals, etc. (See column 4, lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a translucent cling vinyl film 16 having thickness in the range of 2-6 mils in a film 14 of Charley et al with the expectation of providing the desired self-adhering printed window covering since Taylor et al teach that cling vinyl or static cling vinyl having thickness of 2-6 mils can be used for carrying an image thereon to produce stickers for automobile windows (self-adhering window covering), decals, etc.

It is the Examiner's position that a cling decal for covering border of window is in fact window covering as claimed because area of coverage is not recited by the claim. It is held that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Even if it could be argued that a cling decal for covering border of a window is not window covering, area of coverage is a matter of design choice which a person of ordinary skill in

the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Also, the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

It is also the Examiner's position that a window covering of Charley et al in view of Taylor et al would have all claimed properties such as allowing light pass through but diffusing it, since window covering is produced by a process identical or substantially identical processes to that of claimed invention.

It is held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, *claimed properties or functions are presumed to be inherent*. See MPEP 2111.02, 2112.01. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

7. **Claims 5, 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al, as applied above, further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat.

The Examiner Note: "UV inks" in claims 5 and 6 were interpreted according to prior art as UV-curable inks (See De Poortere et al, US 4,070,259, column 10, lines 1-3).

Charley et al in view of Taylor et al fail to teach that inks are sunfast UV inks; and UV-curable varnish contains UV absorber and a hardening agent.

Rega et al teach that UV absorber added to UV curable systems including UV inks provides weathering protection (See column 14, lines 47-63).

GB 2324381 teaches that the use of a crosslinking (hardening) agent in a coating composition improves scratch resistance by promoting crosslinking upon exposure to UV light (See page 6, lines 15-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added UV absorber to UV ink and to UV-curable varnish, and a hardening agent to UV-curable varnish in a colored cling decal of Charley et al with the expectation of providing the colored cling decal with desired UV absorbing properties for weathering protection, as taught by Rega et al, and the desired improved scratch resistance, as taught by GB 2324381.

Charley et al in view of Taylor et al, further in view of Rega et al and GB 2324381 fail to teach that: (i) the window covering protects the interior contents from harmful effects of UV-light (Claims 5, 6); (ii) a printed colored image is assembled from individual pieces (Claim 6).

The advertisement for Solar Stat teaches that the interior contents can be protected from harmful effects of UV-light by covering all surface of window with UV absorbing film.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have covered all surface of window with UV absorbing colored cling decal of Charley et al in view of Taylor et al, further in view of Rega et al and GB 2324381 so that a printed colored image on a window is assembled from individual pieces with the expectation of providing the desired protection of the interior contents from harmful effects of UV-light, as taught by the advertisement for Solar Stat.

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As to claimed recited properties, it is the Examiner's position that the window covering of Charley et al in view of Taylor et al, further in view of Rega et al and GB 2324381, and further in view of advertisement for Solar Stat would have properties substantially identical to those of claimed invention since it is produced by a process identical or substantially identical to that of claimed invention.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy  
Examiner  
Art Unit 1762

February 25, 2003